

RESPONSE TO OFFICE ACTION
DATED SEPTEMBER 3, 2004

Appln. No. 10/764,719

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October 12, 2004

REMARKS

This is in response to the Office Action dated September 3, 2004. Reconsideration is respectfully requested.

Summary of the Invention

The invention concerns an apparatus for playing a game and a method of playing the game with the apparatus. The apparatus comprises a plurality of bodies positioned adjacent to one another, for example, one above another, the bodies being rotatable independently of each other about a common axis. Each body has a plurality of through slots that form display windows that face away from the axis of rotation. Upon rotation, the slots are alignable with one another. The game also includes a plurality of tokens. The tokens have identifying characteristics, such as indicia or color, which separates them into two or more groups depending upon how many players are involved. Players place the tokens in the slots with the object of obtaining a particular pattern of tokens on the bodies. Alignment of slots on two bodies allow a token to be transferred from one body to another. The token slides between the slots and engages slots in both bodies substantially simultaneously during transfer. When the bodies are stacked vertically, this transfer is accomplished by gravity pulling the token from one slot to another. Play of the game proceeds with a series of turns wherein the players insert tokens into slots or turn bodies to align slots and effect transfer of tokens from one body to another.

Summary of Record of Interview Pursuant to 37 CFR 1.133

Applicant thanks the Examiner for granting his attorney, John Chionchio, an interview on October 5, 2004 wherein Claim 1 was discussed in detail along with cited reference U.S. Patent No. 6,581,933 to Zivan. The attorney argued that the slots shown in the reference were not capable of being aligned

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as they were offset in two directions. The Examiner disagreed, but noted that Zivan did not disclose through slots as in applicant's invention, and furthermore, sliding transfer, wherein a token simultaneously engages two slots in two bodies, was also not disclosed. Although no agreement was reached, the attorney proposed amending the claims to recite these distinguishing features.

Summary of the Rejections

Claims 1-17 are pending. Claims 1-5, and 7-13 are rejected as anticipated by U.S. Patent No. 6,581,933 to Zivan. Claim 6 and 14-17 are rejected as obvious over Zivan.

The Argument

Applicant respectfully traverses all of the rejections, contending that the cited reference fails to meet the criteria necessary to support rejections on the basis of anticipation or obviousness. This is shown on a claim-by-claim basis in the arguments presented below.

Claim 1

Claim 1 is rejected as anticipated by Zivan. However, to anticipate a claim, the reference must teach every element of the claim (MPEP, Section 2131, Page 2100-69). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ...claim". Richardson v. Suzuki Motor Co., 9 USPQ2d, 1913, 1920 (Fed. Cir. 1989).

Clearly, the Zivan reference fails to meet the criteria necessary to support a rejection of Claim 1 on the basis of anticipation because Claim 1, as amended, recites that the rotatable bodies have through slots that are alignable with one another upon rotation of the bodies. The claim further recites that a token is slidably transferable between bodies, and the token engages two slots simultaneously during the

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transfer. These characteristics are not taught or even suggested in Zivan.

Applicant's Figure 1 clearly shows body 16 having through slots 38 as recited. Body 16 is rotatable, for example, clockwise as indicated by arrow 24, to bring the slot 38a therein into alignment with the slot 38b in the body 14 positioned beneath it. Slots 38 are brought into alignment in the sense that they allow a token 32 to slide from one slot in one body to another slot in another body. During the transfer, the token simultaneously engages the slots in both bodies as it moves from one slot to the other.

In contrast, none of the slots shown in Zivan are through slots, and none are capable of being brought into alignment to effect the sliding transfer as recited. Examination of Zivan's Figure 1 shows that each body has a different width and a different number of slots, and that no slot on any one body is, or can be, aligned with a slot on another body to effect sliding transfer of tokens between the bodies. For example, the lowermost body has eight slots, the body above it, being smaller, has seven slots. Each slot on the lowermost body is offset laterally from the slots in the body above it by $\frac{1}{2}$ of a slot width. Rotation of the bodies will not bring any slots into alignment so as to effect sliding transfer of tokens between the bodies.

Furthermore, examination of Zivan's Figure 4 shows that the slots on any one body are positioned at a different distance from the axis of rotation than the slots on any other body. For example, the slots on the lowermost body are furthest from the axis, and the slots on the body next to it are closer to the axis of rotation. Thus, the slots shown in Zivan are not only laterally offset from one another, they are also offset from one another in depth. No rotation of the

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bodies will bring any slots into alignment to effect sliding transfer of tokens between slots in the configuration disclosed in Zivan.

In view of the failure of Zivan to teach all elements of Claim 1, i.e., bodies having through slots that are alignable upon rotation of the bodies, applicant contends that the rejection of this claim as anticipated by Zivan is improper and requests that the rejection be withdrawn.

Claims 2-13 depend upon Claim 1, either directly or indirectly, and therefore, should be allowable over Zivan for the same reasons that Claim 1 is allowable.

Claim 4

Claim 4 recites that transfer of tokens from one body to another occurs by gravity upon alignment of the slots on each body. This means that, for a vertical arrangement of the bodies, a token will drop from a slot in a higher body into a slot in a lower body when the slots are aligned. This cannot occur in Zivan because the slots in any one body are not through slots and cannot be aligned with the slots in any other body since they are offset in two planes, i.e., laterally and depthwise as described above with reference to Figures 1 and 4. Zivan does not teach the elements recited in Claim 4 and, therefore, cannot anticipate this claim.

Claim 5

Claim 5 recites that each body has a receptacle positioned at one end and a projection at the opposite end. This is shown in Figure 2, where projections 28 engage receptacles 26. In contrast, Zivan shows, in Figure 2, a body that has no projection, only a receptacle. The projection 18, shown in Figure 4 is not a part of any of the bodies but extends from the base 14. Clearly, Zivan does not anticipate

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Claim 5 because it fails to teach a body having a projection as recited in the claim.

Claim 14

Claim 14 is rejected as obvious over Zivan. However, to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference or references when combined, must teach or suggest all the claim limitations. (MPEP, Section 2143, Page 2100-122.) Zivan fails to meet at least two of the three criteria necessary to establish a prima facie case of obviousness and therefore cannot support a rejection of Claim 14 on the basis of obviousness as explained below.

Claim 14 as amended recites providing a plurality of bodies having through slots that are alignable upon rotation of the bodies. It was shown above for Claim 1 that Zivan does not teach or suggest this recitation, the slots in Zivan not being through slots and being offset in two planes and impossible to align to effect sliding transfer. Therefore, the prima facie case of obviousness is not established because the reference fails to teach or suggest all claim limitations, i.e., alignable through slots in the bodies.

Furthermore, there would be no motivation to modify Zivan by making the slots alignable or through slots. The slots in applicant's game are alignable through slots to facilitate transfer of tokens from one body to another, this being an important tactic in the playing of the game. In contrast, Zivan teaches a word game wherein there is no transfer of tokens between bodies contemplated, the tokens having letters

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thereon to spell words. Zivan, with its ziggurat shape and non-through slots, appears to be specifically designed to prevent alignment of the slots or sliding of the tokens out of a slot. If tokens were transferred between bodies, it would disrupt the play of the game disclosed in Zivan and make the apparatus unsuitable for its intended use. It is well established that "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification". In re Gordon, 221 USPQ 1125 (Fed.Cir. 1984). With no motivation to effect the required modification, Zivan cannot properly support a rejection of Claim 14 on the basis of obviousness because, to establish the prima facie case for obviousness, motivation to modify the reference is one of the three necessary requirements.

It is further noted that the Examiner states that "[i]n order to properly visualize all tokens and slots, it would have been obvious to align the bodies". This shows a misreading of the claim, which recites that the slots, and not the bodies, are alignable. The Examiner's statement, therefore, is irrelevant to Claim 14 in that it fails to address the literal recitation of the claim.

Claims 15-17 depend upon Claim 14 and should be allowable for the same reasons that Claim 14 is allowable. Furthermore, Zivan does not teach or suggest any of the recitations of these claims, nor is there any motivation to modify Zivan in its course of play to remotely resemble the method of play recited in the claims. Zivan teaches a word game, applicant's game is one of positional play using blocking strategies. Zivan is totally irrelevant, and any suggestion for its modification is one of pure hindsight based upon the teachings of the applicant, and not proper motivation which can support a prima facie case of obviousness.

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Summary

Applicant has demonstrated, in the arguments presented above, that Zivan fails to meet the criteria necessary to support rejections of any of applicant's claims on the basis of both anticipation and obviousness. Zivan fails to teach or suggest all elements of any of applicant's claims, and there is no motivation to modify Zivan in a way that would yield applicant's invention.

Applicant contends that the claims are allowable over Zivan, that the application is in condition for allowance and requests that it be passed to issue.

Respectfully submitted,

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